

**REMARKS**

Upon entry of the foregoing amendment, claims 1-6, 9-12, and 14-24 will be pending, claims 1, 9 and 11 will be currently amended, and claims 7-8 and 13 will be canceled. Reconsideration and reexamination of the application is requested in light of applicant's foregoing amendments and subsequent remarks. Applicant respectfully requests that the Examiner withdraw all outstanding objections and rejections.

The amendments to the claims are not believed to enter new matter. The amendments are supported in the original disclosure as filed. For example, the amendments find support in at least the following portions of the original disclosure: the original claims; and at page 11, lines 1-3.

**NOTE REGARDING THE ABSTRACT**

Without objecting to the specification, the Examiner reminded applicant of the proper content of an Abstract of the disclosure. The Abstract, attached at page 17 of the present disclosure, is believed to comport with the stated requirements for an Abstract. Applicant is ready to amend the Abstract to address any specific objections the Examiner may have.

**OBJECTIONS UNDER 37 C.F.R. § 1.75(d)(1)**

The Examiner alleges that the specification does not provide antecedent basis for the term "consisting" in claim 8 or "wherein the specimen is a polymer, glass, or crystalline bead" in claim 9. Applicant presently has canceled claim 8, thereby rendering this objection moot. Applicant has amended claim 9 as shown in the foregoing amendment to the claims. The specification provides antecedent basis for this amendment at page 11, lines 1-3; therefore, the objection should now be withdrawn.

**REJECTION UNDER 35 U.S.C. § 102**

The Examiner rejects claims 1-4, 7, 10-13 and 16-19 under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,195,443 ("Hammond"). Anticipation is proper "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner did not reject claim 8 in view of Hammond. Applicants have cancelled claim 8 and incorporated the subject matter of claim 8 into claim 1. Because the elements of claim 8 are added by the present amendment to claim 1, Hammond does not expressly or inherently describe every element of claim 1 and those claims depending therefrom. Therefore, the rejection should be withdrawn.

Claim 11 has been amended in a manner similar to claim 1. Thus, claim 11 is also not anticipated for similar reasons. Applicant amends the claims thusly to expedite allowance of the present application and does not thereby concede the correctness of the Examiner's rejection or characterization of Hammond.

### **REJECTIONS UNDER 35 U.S.C. § 103(a)**

#### ***The Hammond patent***

The Examiner rejects claim 20 as obvious in view of Hammond. A proper rejection of a claim as obvious requires that the art or combination of art teaches or suggest each and every element of the claims. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claim 20 depends on claim 11, which has been presently amended to recite that the inserted specimen is from blood or urine. This amendment introduces an element into claim 11 similar to that recited in original claim 8, which the Examiner acknowledges is not subject matter contained in Hammond. Because Hammond does not teach every element of claim 11, Hammond likewise cannot teach or suggest every element of claim 20, which depends from claim 11. Accordingly, the rejection should be withdrawn. Applicant amends the claims thusly to expedite allowance of the present application and does not thereby concede the correctness of the Examiner's rejection or characterization of Hammond.

#### ***The Oberhardt patent***

The Examiner rejects claims 1-6, 8-12 and 14-24 as obvious in view of U.S. Patent No. 6,251,615 ("Oberhardt"). A proper rejection of a claim as obvious requires that the art or combination of art teaches or suggest each and every element of the claims. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

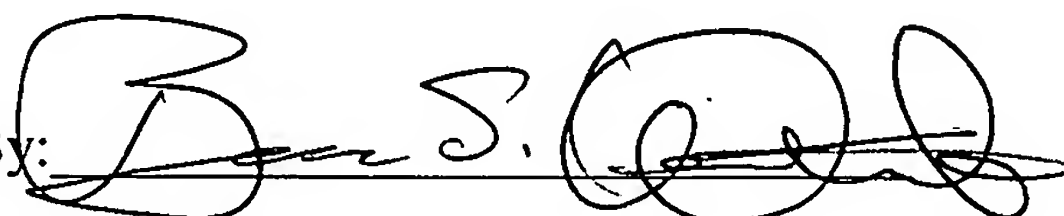
The Examiner acknowledges that Oberhardt does not teach or suggest the elements of claims 7 or 13, which are directed to a flow cell which the specimen flows through without a sheath fluid. These elements are incorporated by the present amendment into independent claims 1 and 11. Because Oberhardt does not teach or suggest each and every element of the independent claims, the rejection with respect to the independent claims and all the dependent claims should be withdrawn.

### CONCLUSION

All the stated grounds for objection and rejection have been properly traversed or rendered moot, and applicant believes that the application accordingly is in condition for allowance. Applicant therefore requests that the Examiner withdraw the present objections and rejections and allow the application. If the Examiner believes that a personal communication would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: May 5, 2004

By: 

Bruce S. Weintraub

Reg. No. 34,277

Attorney for Applicants

Becton, Dickinson and Company  
1 Becton Drive  
Franklin Lakes, New Jersey 07417  
201-847-7096